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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/123,123	07/27/1998	KOICHIRO WATANABE	SONY-P8776	5183

22850 7590 07/29/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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GRIER, LAURA A

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 07/29/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/123,123

Applicant(s)

WATANABE, KOICHIRO

Examiner

Laura A Grier

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 1-19,26 and 29-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-22,24,27 and 28 is/are rejected.
- 7) ☒ Claim(s) 23 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 1-19, 26, 29-63 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.
2. Applicant's election with traverse of figures 1 and 3, and claims 20-25 and 27-28 in Paper No. 11 is acknowledged. The traversal is on the ground(s) that examination of the claims would place a burden on the examiner. This is not found persuasive because the invention (specification) in entirety included 28 drawings, and 8 different embodiments among the drawings in respect to 63 claims, 8 being independent claims.

The requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

3. The disclosure is objected to because of the following informalities: the disclosure comprises several typographical errors.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. **Claims 20-21, 24 and 28** are rejected under 35 U.S.C. 102(b) as being anticipated by McGirr et al., U S. Patent No. 5129098.

Regarding **claim 20 and 24**, McGirr et al. (herein, McGirr) discloses a radio telephone comprising a transmitter with a signal processor for processing audio signals and control signals for transmission (figure 1, col. 3, lines 64-68 and col. 4, lines 1-5), which reads on an audio control transmission apparatus; the radio telephone comprising a receiver for receiving the audio control information and audio signal reads on the apparatus to be controlled and inherently a control instruction is given based on the audio control signal as evident by the fact that a CPU provides the control signal which is processed with the audio signal to provide a combined signal and wherein the CPU control the functions of the transmitter and receiver (col. 3, 64-68 and col. 4, lines 35-40).

Regarding **claim 21**, McGirr discloses everything claimed as applied above (see claim 20). McGirr discloses the CPU, which supports a control instruction input means and audio control signal generating means and the transmitter with the radio telephone itself functions as the signal output means.

Regarding **claim 22**, McGirr discloses everything claimed as applied above (see claim 20). McGirr discloses the signal input means as the receiver of the radio telephone, which comprises a signal processor wherein the transmitted baseband signal is separated into audio signals and controls signals, which indicates extracting the audio control signal from the audio signal, wherein the execution of audio control is inherently executed as evident by the fact that a CPU provides the control signal which is processed with the audio signal to provide a combined

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signal and wherein the CPU control the functions of the transmitter and receiver (col. 3, 64-68 and col. 4, lines 35-40).

Regarding **claim 24**, McGirr et al. (herein, McGirr) discloses a radio telephone comprising a transmitter with a signal processor for processing audio signals and control signals for transmission (figure 1, col. 3, lines 64-68 and col. 4, lines 1-5), which reads on an audio control transmission apparatus; the radio telephone comprising a receiver for receiving the audio control information and audio signal reads on the apparatus to be controlled and the receiver of the radio telephone, which comprises a signal processor wherein the transmitted baseband signal is separated into audio signals and controls signals, which indicates extracting the audio control signal from the audio signal, and inherently a control instruction is given based on the audio control signal as evident by the fact that a CPU provides the control signal which is processed with the audio signal to provide a combined signal and wherein the CPU control the functions of the transmitter and receiver (col. 3, 64-68 and col. 4, lines 35-40).

Regarding **claims 27 and 28**, McGirr discloses everything claimed as applied above (see claim 24). McGirr discloses audio signal and audio control signal as being a basedband signal which is transmitted as a RF carrier signal, which indicates the transmission as a radio wave and/or transmission path (col. 4, line 6-9).

6. **Claims 20 and 24** are rejected under 35 U.S.C. 102(b) as being anticipated by Sato et al., U. S. Patent No. 5203020.

Regarding **claim 20**, Sato et al. (herein, Sato) discloses radio communication apparatus which comprises radio signals transmitted via a base station, wherein the radio signal includes

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audible sound signals and control signals; which reads on an audio control signal transmission apparatus; the portable unit includes audio control unit that includes an audio unit and a control unit, reads on the apparatus to be controlled via CPU (or audio controller) within the audio unit for control the operations of the audio control unit (col. 4, lines 46-55, and col. 4, lines 32-68 and figures 1 and 2).

Regarding **claim 24**, Sato discloses radio communication apparatus which comprises radio signals transmitted via a base station, wherein the radio signal includes audible sound signals and control signals; which reads on an audio control signal transmission apparatus; the portable unit includes audio control unit that includes an audio unit and a control unit, reads on the apparatus to be controlled via CPU within the audio unit for control the operations of the audio control unit (col. 4, lines 46-55, and col. 4, lines 32-68 - col. 5, lines 1-24, and figures 1 and 2), and further the audio circuit of the portable unit extract the audio control signal from the audio signal.

7. **Claims 23 and 25** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### **Prior Art**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mankovitz, U. S. Patent No. US RE37, 131 E discloses an apparatus and methods for music and lyrics broadcasting.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura A Grier whose telephone number is (703) 306-4819. The examiner can normally be reached on Monday - Friday, 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks


Washington, D.C. 20231

**Or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

LAG   
July 24, 2003

  
MINSUN OH HARVEY  
PRIMARY EXAMINER